

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Rillie ) Art Unit: 3634  
Serial No.: 09/376,461 ) )  
Filed: August 18, 1999 ) Examiner: Cohen  
For: SKYLIGHT FLASHING ) )  
 ) 1128.006A  
 ) )  
 ) March 6, 2001  
 ) 750 B Street, Suite 3120  
 ) San Diego, CA 92101  
 )

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BOARD OF PATENT APPEALS  
AND INTERFERENCES

TRANSMITTAL LETTER FOR -REPLY BRIEF

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Commissioner of Patents and Trademarks  
Washington, DC 20231

MAR 12 2001

Dear Sir:

TO 3600 MAIL ROOM

In connection with the Examiner's Answer dated February 27, 2001, enclosed herewith are the following:

- (1) A Reply Brief in 4 pgs;
- (2) Acknowledgment postcard.

Respectfully submitted,

  
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JLR:jg

Encs.

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Date Signed: 3/7, 2001

  
JOHN L. ROGITZ, Attorney of Record  
Registration No. 33,549

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#10

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REPLY BRIEF

Commissioner of Patents and Trademarks  
Washington, DC 20231

Dear Sir:

This brief replies to the Examiner's Answer dated February 27, 2001.

The Answer alleges on page 5, second paragraph, that since the piece of metal from which the Chao et al. flashing is made is seamless, then the resulting flashing *ipso facto* is seamless. This incorrect statement ignores the fact that when the piece of metal is bent around so that the opposite ends are juxtaposed to form the flashing, a seam is made along the resulting joint. It is precisely to avoid such a seam that the present invention has been provided.

Notwithstanding the Examiner's interpretation above that Chao et al. teaches the seamless flashing of Claim 1, the Answer confusingly alleges, on page 6, second paragraph that Chao et al. is really NOT seamless because it contains a weld and, hence, has the "anomaly" of Claim 6. Here, the examiner makes

the observation that seemingly escaped him on page 5 that a welded joint is indeed formed between the ends of the Chao et al. sheet metal.

What is the Examiner's postulated weld, if not a seam? The Examiner, it should go without saying, can't have his cake and eat it too. Either the Examiner regards Chao et al. as having a seamless flashing, or he doesn't. Reading Chao et al. one way to deny patentability to Claim 1 and then reading Chao et al. in the EXACT OPPOSITE way to deny patentability to Claim 6 is perhaps a *sine qua non* example of arbitrary and capricious agency conduct.

Second, the allegation in the Answer that the postulated "weld" of Chao et al. reads on the "anomaly" of Claim 6 ignores the fact that the anomaly is not claimed as an appendage dangling in a vacuum. Rather, it is recited as being part of "a metal skirt extending radially away from the bottom end" of the hollow frustoconical shaped curb. The postulated weld in Chao et al. however, would be on the curb, not the skirt. The Examiner's argument thus entirely ignores a critical limitation of the anomaly set forth in Claim 6.

On page 7, second paragraph, the Answer alleges that "Hoy et al. is provided *only* for its teaching of a seamless element in [the] art, not for the teaching of plastic". This is a direct admission that the law of obviousness has been misapplied, since MPEP §2141.02 requires that "THE PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY" (capitals in MPEP). Indeed, the fact that the vacuum forming process of Hoy et al. can be used only on plastics, not on metal, is a central reason why Hoy et al. cannot be combined with the other references of record as proposed to render the present claims unpatentable. Accordingly, to the extent that the rejections are based on this clearly erroneous understanding of the law, they should be reversed.

On page 8, end of first paragraph, the Answer alleges that "contrary to the purported allegation on page 5 that the examiner must produce a showing in the prior art of "stamping", the Manual requires the examiner to produce a teaching of the prior art only if the limitation is set forth in claim." Once again, this is a direct admission that the MPEP has not been adhered to. MPEP §2144.03 requires production of a prior art showing of a well-known fact if requested, regardless of whether the well-known fact is in the claim. The requirement of MPEP §2144.03 is separate and apart from MPEP §2142, which requires that each and every element of a claim be shown in the prior art to support a *prima facie* case of obviousness. Accordingly, since the Examiner has failed to support his contention about stamping in the field of skylight flashings as required by the MPEP, it cannot be allowed to stand. To the extent that the rejections are based on this unsupported conjecture in violation of the MPEP, they should be reversed.

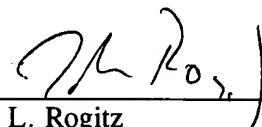
As a housekeeping matter, the Answer alleges on page 6, first paragraph, that "the figures of Chao et al., which are required to contain all the subject matter of the invention, fail to show a seam", as if a "seam" were part of the *claimed* Chao et al. invention. The not-so-subtle implication is that perhaps the present assignee's Chao et al. patent is not valid because drawings must show all elements of an invention, Chao et al. does not show a seam, yet the Examiner has caught Appellant stating that a seam is in Chao et al. This implication of invalidity is based on a non-sequitur because it ignores the fact that the presence or absence of a seam is irrelevant to the claims of Chao et al. Accordingly, it cannot be allowed to go unrebutted on the record.

As the Answer clearly, if unintentionally, demonstrates, the present rejections are based on mutually exclusive readings of Chao et al., and are rife with manifest misunderstandings of the law, compliance with which the Patent Office is charged. Consequently, the rejections should be reversed.

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Page 4

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Respectfully submitted,

  
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